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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/932,621

08/17/2001

Yuichiro Deguchi

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10/28/2008

O'BANION & RITCHEY LLP/ SONY ELECTRONICS, INC.

400 CAPITOL MALL

SUITE 1550

SACRAMENTO, CA 95814

EXAMINER

HASHEM, LISA

ART UNIT

PAPER NUMBER

2614

MAIL DATE

DELIVERY MODE

10/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/932,621	<b>Applicant(s)</b> DEGUCHI, YUICHIRO	
	<b>Examiner</b> LISA HASHEM	<b>Art Unit</b> 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27,30-32,34-37 and 41-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27,30-32,34-37,41-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 7-16-2008 does not comply with 37 CFR 1.321(b) and/or (c) because: the new power of attorney filed on 6-2-2005 lists more than ten patent practitioners and does not conform to 37 CFR 1.321 (c) below from the MPEP:

(c) A power of attorney may only name as representative:

- (1) One or more joint inventors (§ 1.45);
- (2) Those registered patent practitioners associated with a Customer Number;
- (3) Ten or fewer patent practitioners, stating the name and registration number of each patent practitioner. Except as provided in paragraph (c)(1) or (c)(2) of this section, the Office will not recognize more than ten patent practitioners as being of record in an application or patent. If a power of attorney names more than ten patent practitioners, such power of attorney must be accompanied by a separate paper indicating which ten patent practitioners named in the power of attorney are to be recognized by the Office as being of record in the application or patent to which the power of attorney is directed.

A new power of attorney and terminal disclaimer should be filed to address these issues.

### ***Response to Arguments***

2. Applicant's arguments, see Amendment, filed 7-16-08, with respect to the claim rejection(s) of claim(s) 1-27, 30-32, 34-37 and 41-43 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

3. The double patenting rejections filed in the last non-final action are maintained because the terminal disclaimer was disapproved.

***Claim Objections***

4. Claim 19 recites the limitation "the group of broadcast music information". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-27, 30-32, 34-37 and 41-43 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Pat. Appl. No. 2002/0077988 by Sasaki et al, hereinafter Sasaki, in view of U.S. Pat. Appl. No. 2001/0049262 by Lehtonen, in further view of U.S. Pat. Appl. No. 2002/0120577 by Hans et al, hereinafter Hans.

Regarding claim 1, Sasaki discloses a data marker integrated device communication system (Fig. 1, 10; section 0030), comprising:  
a data marker integrated device (i.e. user's computer system) (section 0032) configured to store a data mark (i.e. software program on user's computer system generates meta-data implemented as a content header associated with digital content; content header includes digital content identifier identifying digital content) (section 0033; 0038; 0046; 0056) in response to bookmarking of a broadcast clip (i.e. selecting digital content or audio/video content and downloading digital content on user's computer system) (section 0007; 0033; 0038; 0046; 0055)

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(Sasaki discloses a software program operating on a user's computer system that generates a content header and downloading digital content associated with the content header from a commercial distributor to the user's computer system);

said data marker integrated device comprising a first device (i.e. user's computer system) which is configured for local, short range, communication (section 0032);

a second device (Fig. 3A; i.e. portable media device) (section 0035-0037) configured for establishing a first communication connection with the first device to receive said data mark from said first device (section 0035; 0040; 0046; 0056)

(Sasaki discloses the user's computer system transfers the downloaded digital content to a portable media device that can playback stored digital content);

said second device configured for establishing a separate second connection (section 0046);

a server (i.e. kiosk or another source) configured to connect over said second connection to said second device for data communication through said second device with said first device (section 0032; 0035; 0046; 0047)

(Sasaki discloses connecting the portable media device to a kiosk to download digital content based on the content header originally from the user's computer system);

said second device configured for interfacing with a user in response to communication with said first device and/or said server (section 0035; 0043)

(Sasaki discloses a user of the portable media device can depress a receive button to receive digital content);

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said server is configured for retrieving playlist data (i.e. digit content such as audio or video in a transfer file) (section 0007; 0030; 0047) in response to receipt of said data mark (i.e. content header) from said first device (section 0032; 0047; 0056)

(Sasaki discloses the portable media device can request access to the transfer file including digital contents which is retrieved by the kiosk);

and said server is configured for communicating over a connection with a user terminal (i.e. another portable media device) so that said user terminal can access said playlist data through a user account (i.e. licensed user; registered portable media device and playback software) (section 0040) on said server when connected over said connection (section 0045; 0046; 0047; 0050)

(Sasaki discloses the portable media device can transfer the content header originally from the user's computer system to another portable media device (Fig. 7: 198, 204) and the another portable media device is registered with the system and a user of the another portable media device can access the kiosk for the transfer file including digital contents).

. Sasaki discloses a data mark provides a means by which digital content may be identified by devices in the distribution system. However, Sasaki does not disclose: the data marker integrated device configured for local, short range, wireless communication; the second device configured for establishing a first wireless communication and a second wireless communication; and said server configured for communicating over a data network with a user terminal.

Lehtonen discloses a data marker integrated device communication system (Fig. 3), comprising:

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a data marker integrated device (Fig. 2, 21; Fig. 3, 21; i.e. headset) (section 0011-0014) configured to store a data mark (e.g. index of user files stored in a memory card of the headset; i.e. SONG NAME 1) (section 0039) in response to storing of a clip (e.g. user storing a file, such as a multimedia file, audio/video file, MP3 music file on memory card of the headset) (section 0009, 0016, 0041);

said data marker integrated device comprising a first device (Fig. 3: 27, BT2) which is configured for local, short range, wireless communication (section 0014-0015; 0027); a second device (Fig. 2, 22; Fig. 3, 22; i.e. mobile telephone) (section 0035) configured for establishing a first wireless communication connection (i.e. Bluetooth protocol connection) with the first device to receive said data mark from said first device (section 0037-0040); and said second device configured for establishing a separate second wireless connection (i.e. Internet) (section 0041);

a server (i.e.. computer) configured to connect over said second wireless connection to said device for data communication through said second device with said first device (section 0041) (i.e. sending files from the computer to the headset via the mobile telephone);

said second device configured for interfacing with a user (Fig. 3: UI) in response to said communication with said first device and/or said server (section 0035-0039, 0041; 0042).

Again, Sasaki discloses the claimed system except Sasaki does not disclose a first wireless communication connection, a second wireless communication connection, and a data network. However, the claimed feature of a first wireless communication connection and a second wireless communication connection was old and well known in the art. Lehtonen clearly teaches such concept.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sasaki to include a first wireless communication connection and a second wireless communication connection as taught by Lehtonen. In other words, one of ordinary skill in the art would have been lead to make such a modification of Sasaki to include a data marker integrated device configured for local, short range, wireless communication, such as the headset of Lehtonen, to the system of Sasaki so the data marker integrated device can communicate with a second device over a first wireless communication connection, wherein the first and second device are in vicinity of each other. Further, one of ordinary skill in the art would have been lead to make such a modification of Sasaki to include a second wireless communication, such as the mobile telephone communicating with a computer of Lehtonen, to the system of Sasaki so the second device can establish a separate, second wireless communication connection with a server to transfer data to a first device without the second device being physically connected to the server.

Sasaki in view of Lehtonen do not disclose a data network.

Hans discloses a data marker integrated device communication system (Fig. 1 and 2), comprising:  
a server (i.e. content management server; Fig. 1: 10, 11; Fig. 2, 26) is configured for retrieving playlist data (i.e. digital audio/video content) (section 0020) in response to receipt of a data mark (i.e. content identifier) from a first device (i.e. user node; Fig. 1, 12) (section 0021; 0022; 0029); and said server is configured for communicating over a data network (i.e. Internet) with a user terminal (i.e. personal computer; Fig. 2, 36) so that said user terminal can access said playlist



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data through a user account (i.e. user profile) on said server when connected over said data network (section 0025; 0029).

Again, Sasaki in view of Lehtonen disclose the claimed system except Sasaki discloses a user terminal is connected to the server utilizing a cable port rather than a server communicating over a data network with a user terminal. However, the claimed feature of a server communicating over a data network with a user terminal was old and well known in the art. Hans clearly teaches such concept.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sasaki in view of Lehtonen to include a server communicating over a data network with a user terminal as taught by Hans. In other words, one of ordinary skill in the art would have been lead to make such a modification of Sasaki in view of Lehtonen to include a data network, such as the Internet of Hans, to the system of Sasaki in view of Lehtonen so a user terminal of Sasaki in view of Lehtonen can utilize the Internet to access the playlist from a server without having to be physically connected to the server.

Regarding claim 2, the system of claim 1, (Sasaki: section 0055).

Regarding claim 3, the system of claim 1, (Sasaki: section 0032; Lehtonen: section 0030-0031).

Regarding claim 4, the system of claim 1, (Lehtonen: section 0031; 0036-0037).

Regarding claim 5, the system of claim 1, (Lehtonen: section 0027; 0031).

Regarding claim 6, the system of claim 1, (Sasaki: section 0032; 0046; Lehtonen: 0037).

Regarding claim 7, the system of claim 6, (Lehtonen: Fig. 3, BT; section 0036).

Regarding claim 8, the system of claim 7, (Sasaki: section 0040; 0046; 0047).

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Regarding claim 9, the system of claim 1, (Sasaki: section 0038; 0042; 0047; Lehtonen: section 0038).

Regarding claim 10, the system of claim 1, (Sasaki: section 0046; 0047).

Regarding claim 11, the system of claim 10, (Lehtonen: section 0041).

Regarding claim 12, the system of claim 11, (Lehtonen: section 0041).

Regarding claim 13, the system of claim 11, (Lehtonen: section 0041).

Regarding claim 14, the system of claim 13, (Lehtonen: section 0041; 0052).

Regarding claim 15, the system of claim 1, (Hans: section 0025).

Regarding claim 16, the system of claim 15, (Hans: section 0025).

Regarding claim 17, the system of claim 15, (Hans: section 0025).

Regarding claim 18, the system of claim 15, (Hans: section 0020-0022; 0025).

Regarding claim 19, the system of claim 18, (Sasaki: section 0038; 0042; 0055; 0056).

Regarding claim 20, please see the rejection in claim 1 to reject the method in claim 20, wherein Sasaki in view of Lehtonen in further view of Hans discloses:

transmitting said received data mark over said second wireless connection to a user account within a server (Sasaki: section 0047; Lehtonen: section 0041; Hans: section 0025; 0029); and retrieving information corresponding to said marked data from a storage unit coupled to said server (Sasaki: section 0047; 0055-056; Lehtonen: section 0041; Hans: section 0025; 0029).

Regarding claim 21, the method of claim 20, (Lehtonen: section 0027; 0031).

Regarding claim 22, the method of claim 20, (Sasaki: section 0038; 0042; 0047; Lehtonen: section 0038).

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Regarding claim 23, the method of claim 22, (Sasaki: section 0038; 0042; 0047; Lehtonen: section 0038).

Regarding claim 24, the method of claim 20, (Lehtonen: section 0031; 0036-0037)

Regarding claim 25, the method of claim 20, (Lehtonen: section 0041).

Regarding claim 26, the method of claim 25, (Lehtonen: section 0041).

Regarding claim 27, the method of claim 25, (Lehtonen: section 0041; 0052).

Regarding claim 30, the method of claim 20, (Sasaki: section 0038; 0042; 0055; 0056).

Regarding claim 31, please see the rejection to the system in claim 1 above, to reject the method in claim 31.

Regarding claim 32, the method of claim 31, (Sasaki: section 0038; 0042; 0047; Lehtonen: section 0038).

Regarding claim 34, the method of claim 31, (Lehtonen: section 0036; 0041).

Regarding claim 35, the method of claim 31, (Lehtonen: section 0041).

Regarding claim 36, the method of claim 35, (Lehtonen: section 0041).

Regarding claim 37, the method of claim 31, (Lehtonen: section 0041; 0052).

Regarding claim 41, the method of claim 31, (Sasaki: section 0038; 0042; 0055; 0056).

Regarding claim 42, please see the rejections to claims 1 and 20 to reject the system in claim 42.

Regarding claim 43, please see the rejections to claims 1, 20, and 31 to reject the system in claim 42.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

8. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

9. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-27, 30-32, 34-37, and 41-43 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U. S. Patent No. 7,127,454 and claims 1-26 of U.S. Patent No. 7,107,234. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 1-18 of the '454 patent and claims 1-26 of the '234 patent pertain to the same subject matter as the instant application including: ‘...a data marking device configured to store a data mark in response to bookmarking of a broadcast clip...’, ‘...a second device to receive said data mark from said data marking device...’, and ‘...a server for retrieving playlist data in response to receipt of said data mark from said data marking device...’.

However, the claims in the '454 patent and the '234 patent do not disclose a server configured to connect over a second, separate connection to a second device for data communication through the second device with a first device which is connected over a first wireless connection to the second device and the server is configured for retrieving playlist data in response to receipt of a data mark from said first device.

Examiner takes **official notice** that the element '...a server configured to connect over a second, separate connection to a second device for data communication through the second device with a first device which is connected over a first wireless connection to the second device and the server is configured for retrieving playlist data in response to receipt of a data mark from said first device...' is well known in the art and can be combined with the patented claims to read on the claims of the instant application.

Thus, it would have been obvious to one of ordinary skill in the art to modify the patents to provide a server configured to connect over a second, separate connection to a second device for data communication through the second device with a first device which is connected over a first wireless connection to the second device and the server is configured for retrieving playlist data in response to receipt of a data mark from said first device

11. Claims 1-27, 30-32, 34-37, and 41-43 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 7,190,971, claims 1-17 of U.S. Pat. No. 7,062,528, and claims 1-61 of U.S. Patent No. 6,578,047.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both patents pertain to the same subject matter as the instant application

including: ‘...a device storing information providing a means by which content elements may be identified by an external means, such as a server...’.

However, the claims in the ‘971 patent, ‘528 patent, and ‘047 patent do not disclose a data marking device configured to store a data mark in response to bookmarking of a broadcasting clip or music file in order to store and remind a user of preferred content selected by the user.

Examiner takes **official notice** that the limitation ‘...a data marking device configured to store a data mark in response to bookmarking of a broadcasting clip or music file in order to store and remind a user of preferred content selected by the use...’ is well known in the art and can be combined with the patented claims to read on the claims of the instant application.

Thus, it would have been obvious to one of ordinary skill in the art to modify the patents to provide a data marking device configured to store a data mark in response to bookmarking of a broadcasting clip or music file in order to store and remind a user of preferred content selected by the user.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.

The reference U.S. Pat. Appl. Publ. No. 2002/0145589 by Tree has a common assignee with the instant application.

This reference teaches all the limitations in claims 1, 20, 31, 42, and 43 in sections 0023 and 0041, except:

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a server for communicating over an Internet connection with a user terminal so that said user terminal can access said playlist data through a user account on said server when connected over said Internet. Thus, Tree can be used in a proposed 103(a) rejection.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This proposed rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Appropriate action is required.

13. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-8300 (for formal communications intended for entry)

**Or call:**

(571) 272-2600 (for customer service assistance)

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LISA HASHEM whose telephone number is (571)272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fan Tsang/  
Supervisory Patent Examiner, Art Unit 2614  
/Lisa Hashem/  
Examiner, Art Unit 2614  
October 25, 2008